

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Confirmation No.: 9073

Eva-Maria LEPPANEN *et al.*

Group Art Unit: 2442

Serial No.: 10/530,759

Atty. Docket No.: 059643.00602

Filed: June 23, 2005

Examiner: Jason D. Recek

For: COMMUNICATION SYSTEM

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

March 12, 2010

Sir:

Applicants hereby submit this Pre-Appeal Brief Request for Review ("PABRR") of the final rejections of claims 1-31 in the above identified application. Claims 1-31 were finally rejected in the Final Office Action dated October 26, 2009 ("Office Action"). Applicants filed a Response to the Office Action on February 12, 2010 ("Applicants' Response"). The Office issued an Advisory Action dated March 2, 2010 ("Advisory Action"). Applicants hereby appeals these rejections and submits this PABRR. A Notice of Appeal is timely filed concurrently herewith.

The Office Action rejected claims 1-31 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0083127 of Agrawal ("Agrawal") in view of U.S. Patent Application Publication No. 2004/0062383 of Sylvain ("Sylvain"). However, as is demonstrated by the record, including an entered Declaration under 37 C.F.R. § 1.131 and accompanying corroborating evidence of an invention disclosure report and e-mail correspondence record, Sylvain is not prior art with respect to the claimed invention. Thus, any rejection utilizing Sylvain is clear error.

The present application, filed on June 23, 2005, is a U.S. National Stage Application of PCT Application No. PCT/IB2002/004388, filed on October 9, 2002. The claimed invention was conceived prior to October 1, 2002, as evidenced by the Invention Disclosure Report submitted with the response filed February 12, 2010, and already of record. Further, reasonable diligence, or due diligence as it may be termed, was conducted from before October 1, 2002, continuing to the constructive reduction to practice by the filing of PCT Application No. PCT/IB2002/004388 on October 9, 2002, upon which the present application is properly based.

Sylvain was filed on October 1, 2002, and published April 1, 2004. Thus, Sylvain is antedated, since the present invention was conceived prior to Sylvain's filing date, and reasonable diligence was employed from before Sylvain's filing date to the priority date of the present application. Therefore, Sylvain is not prior art as to the present application.

Accordingly, Applicants respectfully submit that the rejection is overcome, and respectfully request that this rejection be withdrawn. The Advisory Action, however, failed to withdraw the rejection.

The Advisory Action indicated that the Declaration Under 37 C.F.R. §1.131 has been entered. The Advisory Action asserted, however, that the request for reconsideration did not place the application in condition for allowance. The Advisory Action argued that the Declaration was ineffective to overcome Sylvain (U.S. 2004/0062383). Applicants respectfully submit that this determination constitutes clear error.

The Advisory Action provides three reasons why the Declaration is allegedly ineffective. The first reason is that allegedly the invention report does not show that the features of the claims for which Sylvain was cited were possessed by the inventor at the time that the invention report was written. Sylvain was cited with respect to "wherein second information is definable by the watcher," as recited (for example) in claim 1. However, the invention report refers repeatedly to this feature. For example, in Section 1, the invention report refers to "a case when the user (called 'watcher') requests presence information of the set of other users by making a group subscription." Likewise, in Section 6, the invention report states that "Watcher gives presence list filtering rules in subscribe request and based on that information presence list server is able to create filtering rules for all individual subscriptions which will be sent to presentities."

Thus, the invention report does show possession by the inventor of the feature "wherein second information is definable by the watcher," as recited (for example) in claim 1. As explained in MPEP 2163.02 (discussing the analogous written description requirement), "The subject matter of the claim need not be described literally (i.e., using the same terms or *in haec verba*) in order for the disclosure to satisfy the description requirement." Thus, it is not significant that the exact phrase "wherein second information is definable by the watcher" does not appear, in so many words, in the invention report. Possession can be, and has been, demonstrated without the need for showing that the exact words were used.

Applicants note that the standard is that the Declaration shows possession of the invention as a whole, though Applicants have focused on the features discussed in the Advisory Action.

The second reason referred to in the Advisory Action is that “the affidavit leaves gaps of time unaccounted for between each recited event” and “applicant’s remarks only mention ‘reasonable diligence.’” Applicants respond to each of these allegations separately.

As to gaps, the Advisory Action is not correct. There are no relevant gaps unaccounted for. Specifically, the evidence of record shows:

- September 23, 2002 – drafting order requesting application filing by October 9, 2002, sent by email
- September 24, 2002 – drafting attorney requests meeting with inventors to discuss invention, sent by email
- September 25, 2002 – first inventor responds with availability for meeting, sent by email
- September 25, 2002 – second inventor responds with availability for meeting, indicating that only Monday afternoon (October 1, 2002) would be possible of the two dates identified by the first inventor, sent by email
- September 25, 2002 – third inventor responds with availability for meeting, but only at a time that does not correspond with the time for the first two inventors, sent by email
- September 27, 2002 – drafting attorney suggests meeting location, sent by email
- September 27, 2002 – first inventor confirms location and requests time, sent by email
- September 27, 2002 – drafting attorney responds with time of 2:00 p.m., sent by email
- October 1, 2002 – meeting held (according to the plan to meet on the Monday at 2 p.m.)
- October 9, 2002 – priority application filed as planned all along

This continuous forward progress toward the filing of a patent application demonstrates reasonable or due diligence in the reduction-to-practice. Sixteen days from engaging a patent attorney to the filing of a patent application clearly demonstrates due diligence. There is an 8 day “gap” in the record from October 1 to October 9. That gap is explained by the drafting attorney diligently preparing the application for filing. The CCPA (predecessor to the Federal Circuit) has held that a lapse of time of approximately two weeks for the inventors to review an application falls within the limits of reasonable delay. *Sletzinger v. Lincoln*. 410 F.2d 808, 161 USPQ 725, 728-729 (1969).

Furthermore, it is well established that diligence in the critical period, from just before the second conceiver’s entrance to the first conceiver’s constructive reduction to practice, can be established by reliance on the diligence of the drafting attorney. The CCPA explained in *Hull v. Davenport*, 90 F.2d 103, 105 (C.C.P.A. 1937):

The weight of authority, however, regards his diligence sufficiently shown if it be found that he was diligent from a time

just prior to the second conceiver's entrance into the field to the first conceiver's reduction to practice either actually or constructively. *Christie v. Seybold*, 55 F. 69; *Woods v. Poor*, 29 App. D.C. 397; *Grundy v. Van Leir*, 22 C.C.P.A. 1034, 75 F.2d 503; *Wilson et al. v. Sherts et al.*, 23 C.C.P.A. 914, 81 F.2d 755.

...

It is also well settled that the first conceiver cannot account for his failure to reduce his invention to practice for an unreasonable time after his conception by showing that he merely turned the matter over to his attorney if in fact the attorney in preparing the application and getting it into the Patent Office showed inexcusable lack of diligence. *Briggs v. Lillie et al.*, 1905 C. D. 168. Of course, in determining the diligence or the lack of diligence on the part of the attorney, considerations are involved unlike those in many respects which appertain to the inventor. Courts have been liberal in their holdings with respect to the length of time a busy patent attorney may take in the preparation and filing of patent applications. *Farmer et al. v. Schweyer*, 21 C.C.P.A. 865, 68 F.2d 961. In one case, *Courson v. O'Connor et al.*, 227 F. 890, it was held that lack of diligence will not be imputed to the attorney unless the same amounts to negligence, but the weight of authority hardly goes this far. It requires that he must show reasonable diligence (*see Briggs v. Lillie et al.*, *supra*, and *Martus et al. v. Heise*, 17 C.C.P.A. 1083, 39 F.2d 715) and that his lack of diligence must be charged against his client.

In this case, the application was diligently and reasonably handled by the drafting attorney. The record establishes that the application was filed sixteen days from when the invention disclosure was provided to the drafting attorney, and that the drafting attorney began immediately to arrange a meeting with the inventors to discuss the invention. Two of the inventors met with the drafting attorney on the very day that Sylvain was filed, and the priority application for the present application was filed eight days later. There has been no suggestion that eight days is an unreasonable amount of time to draft a patent application, and it is clear from the record that diligence was used in obtaining the inventors' input for drafting the application. Indeed, the application was filed by the deadline initially requested when the drafting order was submitted.

The Advisory Action did not dispute the fact that eight days (or even two weeks) is a reasonable length of time for the attorney to prepare and file a patent application based on the invention report. As noted above, two weeks has been held to be a reasonable amount of time for the inventors to review a prepared application. Consequently, it would be

unreasonable to suppose that eight days is an unreasonable delay in the preparation and filing of a patent application.

As to “reasonable diligence,” the Advisory Action attempts to suggest that “reasonable diligence” is not “due diligence.” Applicants respectfully submit that while the words themselves are not the same, the concepts are equivalent. The MPEP does not draw a distinction between the two and appears to use the two terms interchangeably. For example, MPEP 715.07 (III)(C) explains the prior invention can be established by showing *inter alia*: “conception of the invention prior to the effective date of the reference coupled with due diligence from prior to the reference date to the filing date of the application (constructive reduction to practice)” but then in the explanation immediately following uses the expression “reasonable diligence” as an equivalent. Thus, for the purposes of MPEP 715.07, which is the relevant section of the MPEP, the two concepts are the same. Furthermore, it should be apparent that it would be unreasonable for due diligence to be more than reasonable diligence.

The third reason that the Advisory Action has listed for the Declaration being ineffective relates to actual reduction to practice. The Declaration did not aim to demonstrate actual reduction to practice, but instead according to the way described in MPEP 715.07 (III)(C). Thus, the third reason in the Advisory Action is irrelevant.

In view of the above, it is clear that Sylvain is not available as prior art in this application. Therefore, the rejection over Agrawal and Sylvain is clearly in error, and must be withdrawn.

Reconsideration and withdrawal of the rejections, in view of the clear errors in the Office Action, is respectfully requested. In the event this paper is not being timely filed, the applicants respectfully petition for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account 50-2222.

Respectfully submitted,

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Enclosures: Notice of Appeal; PTO/SB/33 Form; Petition for Extension of Time